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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/000,366	01/28/1998	MASAHITO HOASHI	HOASHI=2	5189

1444 7590 04/19/2002

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EXAMINER	
BECKER, DREW E	

ART UNIT	PAPER NUMBER
1761	30

DATE MAILED: 04/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

T-D-30

Office Action Summary	Application No. 09/000,366	Applicant(s) HOASHI ET AL.	
	Examiner Drew E Becker	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 February 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 3-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,096,367. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to use the milled fish meat of 6,096,367 in an electrically-heated kamaboko product since comminuted fish was the primary ingredient of kamaboko as taught by Katoh et al [Pat. No. 4,950,494] and since kamaboko was commonly heated by electricity as taught by JP 06133739A.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 3-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1 and 7 recite "it". It is not clear what "it" is.

6. Claim 8, line 15 recites "the same". It is not clear what "the same" is.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 3-6, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over CA 1213170A.

CA 1213170A teaches a method for thawing frozen ground meat by comminuting the frozen meat in two steps (page 15, lines 4-20), thawing with elevated temperature and without mashing or additives (page 16, lines 15-25), and comminuting to 0.125-0.75" or 3-19 mm (page 6, lines 11-12). Although not specifically recited, it would have been obvious to one of ordinary skill in the art to use fish as the meat source of CA 1213170A since CA 1213170A teaches using "other edible animal flesh" (page 6, line 8) which fish certainly is, and since fish was commonly used in ground form such as for kamaboko products.

3. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over CA 1213170A as applied above, in view of Katoh et al [Pat. No. 4,950,494].

CA 1213170A teaches the above mentioned concepts. CA 1213170A does not teach using a pin mixer to stir in additives such as seasoning, starch, sugar, or polyphosphate. Katoh et al teach a method of processing fish paste by mixing in seasoning and starch (column 7, line 5) by using a pin mixer (Figure 1). It would have been obvious to one of ordinary skill in the art to incorporate the mixing of Katoh et al into the invention of CA 1213170A since both are directed to methods of processing ground meat, since pin mixers were commonly used to add ingredients to ground meat as shown by Katoh et al, and since additives were commonly known to enhance flavor and provide other advantages.

4. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh et al in view of CA 1213170A and JP 06133739A.

Katoh et al teach a method of producing kamaboko by molding thawed, ground fish paste (column 6, lines 42-51) and heating the molded fish in two steps to induce gelling (column 6, lines 53-64). Katoh et al do not teach milling frozen, ground fish meat or heating with electricity. CA 1213170A teaches a method for thawing frozen ground meat by milling the frozen meat (page 15, lines 4-20) and thawing with elevated temperature (page 16, lines 15-25). JP 06133739A teaches a method of producing molded fish paste products by heating with electricity (abstract). It would have been obvious to one of ordinary skill in the art to incorporate the milling of CA 1213170A into the invention of Katoh et al since both are directed to producing ground meat products, since Katoh et al

already teaches thawing (column 7, line 1), and since milling prior to thawing would result in reduced thawing time due to the reduction in surface area in relation to volume as taught by CA 1213170A (page 6, lines 13-20). It would have been obvious to one of ordinary skill in the art to incorporate the electric thawing of JP 06133739A into the invention of Katoh et al since both are directed to the processing of fish paste products, since Katoh et al already includes heating, and since electric heating was commonly known and used for fish paste products as shown by JP 06133739A.

Response to Arguments

1. Applicant's arguments filed February 20, 2002 have been fully considered but they are not persuasive.

Applicants argue that the Double Patenting rejection should be withdrawn since the amended claims exclude shearing and cites JP 60-70049 as evidence. This is a moot point since the claims of 6,096,367 do not include shearing.

Applicants argue that CA 1213170A does not teach thawing at elevated temperatures. However, applicants' attention is drawn to page 16, lines 15-26 of CA 1213170A which specifically teach this method as an alternative to packaging and freezing.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E Becker whose telephone number is 703-305-0300. The examiner can normally be reached on Monday-Thursday 7am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1495.

Drew Becker
April 17, 2002

KEITH HENDRICKS
PRIMARY EXAMINER